

REMARKS

SECTION 101 REJECTIONS

Claims 1-45 are rejected under 35 USC 101 as not falling within one of the four statutory categories of invention.

Claim(s) 1-45 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

In response, claims 1-45 have been cancelled. New independent claims 46, 55, 66 and 85 include “modifying one or more parameters... by a computer processor in the local client computer...”.

Withdrawal of Section 101 rejections on claims 1-45 is respectfully requested.

SECTION 102 REJECTIONS

Claims 1, 3-23, 25-27, 30, 31 and 33-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilkins, US 2004/0133924 A1, “Techniques for Synchronizing any of a Plurality of Associated Multimedia Assets in a Distributed System”.

In response, claims 1, 3-23, 25-27, 30, 31 and 33-45 have been cancelled. Withdrawal of Section 102 rejections on claims 1, 3-23, 25-27, 30, 31 and 33-45 is respectfully requested.

Newly added claims are discussed below in detail in regard to the Wilkins reference.

CLAIMS 46-54

Claim 46 recites the following:

A method for manipulating a digital image comprising:

identifying an image associated with a user on a local client computer;

defining a personal template that describes a specific configuration of one or more parameters that describe manipulations to be applied to the image, wherein the personal template is configured to describe manipulations to be applied to different images associated with the same user;

sending the image from the local client computer to a remote server;

storing the personal template in association with the image on the local client computer and the remote server;

modifying one or more parameters in the personal template, by a computer processor in the local client computer or a remote processor in communication with the remote server, without manipulating the image itself; and

synchronizing the personal templates on the local client computer and the remote server.

In the instant application, the concept of personal template is discussed, for example, on page 26, lines 4-7:

In one implementation, image processing software 109 and image manipulation software 117 allow users to create personal templates that define a particular set or chain of image processing operations often used by a user. The personal template can be used again by the same user and stored in either storage medium 110 or image database 114.

Office Action cited paragraph [0075] in the rejection of claim 22. Paragraph [0075] recites the following:

“A third embodiment combines the benefits of the first two embodiments. The edit list not only represents the state description of operations, but also includes the ability for one or more of the operations that are part of the state description to be a list of individual operations that are to be applied to the photo, thus merging the two methods.”

The phrase “individual operations” in Wilkins simply means “separate or unique operations”. Wilkins does not include a set of parameters that can be used and reused on images associated with a user.

Wilkins thus does not teach, in paragraph [0075] or other section, the elements “defining a personal template that describes a specific configuration of one or more parameters that describe manipulations to be applied to the image” and “wherein the personal template is configured to describe manipulations to be applied to different images associated with the same user” in claim 46.

Furthermore, regarding claim 47, Wilkins does not include “the one or more parameters include an identifier for the personal template” in paragraph [0075] or other sections of the specification.

Regarding claim 48, Wilkins does not include “a proxy image that is a lower resolution version of the image”. The “resultant proxy image” in Wilkins is a “modified image” not “a lower resolution version of the image” (which is not modified except for the lower resolution). For example, Wilkins describes in paragraph [0031]: “the modified image (also known as a resultant proxy image)”.

Regarding claim 49, Wilkins does not include “checking for conflicts between the personal templates stored on the local client computer and the remote server; and upon detecting a conflict, alerting the user to the conflict”. Wilkins recites in paragraph [0116] lines 15-22:

“This synchronization can be accomplished efficiently and automatically by, in one embodiment, transparently transferring the update edit list to all those linked remote devices onto which all the associated photo(s) reside. In other embodiment, the variously distributed photos can be synchronized by transferring the modified photos themselves (i.e., the resultant images with the edits applied) when network usage vs. processor time on the computer receiving the updated edit list is a consideration.”

There is no disclosure about “checking for conflicts between the personal templates stored on the local client computer and the remote server; and upon detecting a conflict, alerting the user to the conflict”.

Regarding claim 50, Wilkins does not include “receiving, from the user, a selection regarding adopting one of the personal templates stored on the local client computer and the remote sever; and synchronizing the personal templates stored on the local client computer and the remote sever according to selection”.

Regarding claim 51, Wilkins does not include “storing two different states of the personal templates at each of the local client computer and the remote server, one state containing a different set of conflicting parameters”.

Applicant respectfully notes that Office Action did not include explanations to the rejection to claim 28 regarding the limitations of “storing two different states...”.

Regarding claim 52, Wilkins does not include “the one or more parameters describe a border to be applied around the image”.

Regarding claim 53, Wilkins does not include “wherein the one or more parameters include annotation to be inserted in the image”.

Regarding claim 54, Wilkins does not include “capturing a history of states of the one or more parameters; and selecting one of the history of states without traversing back through each intermediary state in the history”.

The Office Action cited paragraph [0055] (in rejecting claim 13) which recites:

An alternative embodiment is to use this list to represent a state description of each operation applied to the photo, in which certain operations can be turned on or off. Each operation can still have an optional parameter list associated with the command, but **there is a single "state" for the operation. It is either "on" or "off"**, and if "on", it can have a parameter associated with it. The advantage of this structure is that the operations and the interaction between the operations are clearly defined by the structure, thus providing consistent results regardless of the order that the user has applied the operations. Either the XML syntax could define the order in which the operations are performed, similar to the first embodiment, or the application can define it, independent of the order in which they appear in the XML file. The key point is that each operation is either "on" or "off" and would normally not appear more than once on the edit list. A second sample piece of XML code is included for illustrative purposes:

Paragraph [0055] emphasizes there is only **a single "state" for the operation. It is either "on" or "off"** in the edit list. There is no disclosure about “a history of states of the one or more parameters” or “selecting one of the history of states without traversing back through each intermediary state in the history”.

In sum, one or more elements in each of claims 46-54 are missing in Wilkins. Claims 46-54 cannot be anticipated by Wilkins under Section 102.

CLAIMS 55-65

Claim 55 recites the following:

A method for manipulating a digital image comprising:
 identifying an image on a local client computer;
 defining one or more parameters that describe manipulations to be applied to the image, wherein the one or more parameters include annotation to be inserted in the image;
 sending the image from the local client computer to a remote server;
 storing the one or more parameters in association with the image on the local client computer and the remote server;
 modifying the one or more parameters, by a computer processor in the local client computer or a remote processor in communication with the remote server, without inserting the annotation in the image itself; and

synchronizing the one or more parameters on the local client computer and the remote server.

In the instant application, inserting annotation to an image is disclosed in many locations such as the section on page 14, lines 11-19:

As described above, synchronization occurs each time a connection to the user's account at the online photofinisher's website is made. State information of the user account is updated on the user computer and on the web. The state information can include image transfers or upload, the transfer of the image file name, image processing information, image archival information, annotation and back printing information, UI state information, personal template, order information. In one implementation, any input information on the user's computer will be automatically uploaded to the user account on the web without requiring the user to log onto the website.

The Office Action cited paragraph [0102] (in rejecting claim 17) which recites the following:

“It should also be noted that the edit list data associated with a reference proxy image can point to multiple digital negatives and other multimedia content used in the creation of the reference proxy image. This can include vector images (such as PostScript, EPS, or PDF), raster images (such as JPEG, TIFF, or PNG), **text strings**, video, sound, and the like.”

Applicant has carefully examined text strings in the edit list Wilkins. For example, Wilkins describes from paragraph [0035] to paragraph [0074]:

```
[0069] <!--color_adjustment and auto_fix are both enabled and applied to the-->  
[0071] <EDIT-COMMAND state="on" type="color_adjustment" red="10" green="-  
20" blue="50" />  
[0072] <EDIT-COMMAND state="on" type="auto_fix"/>
```

The text strings in the edit list are intended to describe image processing to be applied to the image. Applicant has carefully examined the entire specification of Wilkins, there is no mention of annotation to be inserted in an image and storing the annotation message in an edit list.

Wilkins therefore does not include “defining one or more parameters that describe manipulations to be applied to the image, wherein the one or more parameters include

annotation to be inserted in the image” and “modifying the one or more parameters, by ... without inserting the annotation in the image itself” in claim 55.

Furthermore, regarding claim 59, Wilkins does not include “the print parameters include information to be printed on the back of an image print based on the image” in paragraph [0091] (cited in the Office Action regarding rejection of claim 18) or other sections of the specification.

Regarding claim 59, Wilkins does not include “a proxy image that is a lower resolution version of the image”. The “resultant proxy image” in Wilkins is a “modified image” not “a lower resolution version of the image” (which is not modified except for the lower resolution). For example, Wilkins describes in paragraph [0031]: “the modified image (also known as a resultant proxy image)”. Wilkins does not teach “inserting the annotation to a proxy image” or “the proxy image containing the annotation”.

Regarding claim 61, Wilkins does not include “checking for conflicts between the personal templates stored on the local client computer and the remote server; and upon detecting a conflict, alerting a user to the conflict”. Wilkins recites in paragraph [0116] lines 15-22:

“This synchronization can be accomplished efficiently and automatically by, in one embodiment, transparently transferring the update edit list to all those linked remote devices onto which all the associated photo(s) reside. In other embodiment, the variously distributed photos can be synchronized by transferring the modified photos themselves (i.e., the resultant images with the edits applied) when network usage vs. processor time on the computer receiving the updated edit list is a consideration.”

There is no disclosure about “checking for conflicts between the personal templates stored on the local client computer and the remote server; and upon detecting a conflict, alerting a user to the conflict”.

Regarding claim 62, Wilkins does not include “receiving, from the user, a selection regarding adopting one of the personal templates stored on the local client computer and the remote sever; and synchronizing the personal templates stored on the local client computer and the remote sever according to selection”.

Regarding claim 63, Wilkins does not include “storing two different states of the one or more parameters at each of the local client computer and the remote server, one state containing a different set of conflicting parameters”.

Applicant respectfully notes that Office Action did not include explanations to the rejection to claim 28 regarding the limitations of “storing two different states...”.

Regarding claim 64, Wilkins does not include “wherein the one or more parameters describe a border to be applied around the image”.

Regarding claim 65, Wilkins does not include “capturing a history of states of the one or more parameters; and selecting one of the history of states without traversing back through each intermediary state in the history”.

The Office Action cited paragraph [0055] (in rejecting claim 13) which recites:

An alternative embodiment is to use this list to represent a state description of each operation applied to the photo, in which certain operations can be turned on or off. Each operation can still have an optional parameter list associated with the command, but **there is a single "state" for the operation. It is either "on" or "off"**, and if "on", it can have a parameter associated with it. The advantage of this structure is that the operations and the interaction between the operations are clearly defined by the structure, thus providing consistent results regardless of the order that the user has applied the operations. Either the XML syntax could define the order in which the operations are performed, similar to the first embodiment, or the application can define it, independent of the order in which they appear in the XML file. The key point is that each operation is either "on" or "off" and would normally not appear more than once on the edit list. A second sample piece of XML code is included for illustrative purposes:

Paragraph [0055] emphasizes there is only **a single "state" for the operation. It is either "on" or "off"** in the edit list. There is no disclosure about “a history of states of the one or more parameters” or “selecting one of the history of states without traversing back through each intermediary state in the history”.

In sum, one or more elements in each of claims 55-65 are missing in Wilkins. Claims 55-65 cannot be anticipated by Wilkins under Section 102.

CLAIMS 66-84

Claim 66 recites the following:

A method for manipulating a digital image comprising:
 identifying an image on a local client computer;
 defining one or more parameters that describe manipulations to be applied to the image, wherein the one or more parameters describe a border to be applied around the image;
 sending the image from the local client computer to a remote server;
 storing the one or more parameters in association with the image on the local client computer and the remote server;

modifying the one or more parameters, by a computer processor in the local client computer or a remote processor in communication with the remote server, without applying the border to the image itself; and
synchronizing the one or more parameters on the local client computer and the remote server.

In the instant application, applying a border to an image is disclosed in many locations such as the section on page 17, lines 2-9:

A set of attributes for the image-based product (also referred to here as “product attributes”) is received (block 402). In the case of an image print, the product attributes can include, for example, the size of the image print, the number and identity of the images included in the image print, cropping information, and **the size, style, and color of any border** surrounding the image portion of the image print. The set of attributes can be received from the user, for example, by having the user enter or select attributes using a browser executing on the client computer 104 or as part of state information provided by the client computer 104 in a synchronization process.

Wilkins does not include image borders or properties of image borders throughout the specification. Wilkins does not include “defining one or more parameters that describe manipulations to be applied to the image, wherein the one or more parameters describe a border to be applied around the image” and “modifying the one or more parameters... without applying the border to the image itself” in claim 66.

Furthermore, regarding claim 67, Wilkins does not include “the one or more parameters include at least one of a border width, a style, or a color which defines the border” in any section of the specification.

Regarding claim 69, Wilkins does not include 69 “the one or more parameters include information to be printed on the back of an image print based on the image”. Wilkins does not teach back printing or information to be printed on the back of the image prints.

Regarding claim 70, Wilkins does not include “a proxy image that is a lower resolution version of the image”. The “resultant proxy image” in Wilkins is a “modified image” not “a lower resolution version of the image” (which is not modified except for the lower resolution). For example, Wilkins describes in paragraph [0031]: “the modified image (also known as a resultant proxy image)”. Wilkins does not teach “applying the border to a proxy image” or “displaying the proxy image having the border”.

Regarding claim 71, Wilkins does not include “checking for conflicts between the personal templates stored on the local client computer and the remote server; and upon

detecting a conflict, alerting a user to the conflict”. Wilkins recites in paragraph [0116] lines 15-22:

“This synchronization can be accomplished efficiently and automatically by, in one embodiment, transparently transferring the update edit list to all those linked remote devices onto which all the associated photo(s) reside. In other embodiment, the variously distributed photos can be synchronized by transferring the modified photos themselves (i.e., the resultant images with the edits applied) when network usage vs. processor time on the computer receiving the updated edit list is a consideration.”

There is no disclosure about “checking for conflicts between the personal templates stored on the local client computer and the remote server; and upon detecting a conflict, alerting the user to the conflict”.

Regarding claim 72, Wilkins does not include “receiving, from the user, a selection regarding adopting one of the personal templates stored on the local client computer and the remote sever; and synchronizing the personal templates stored on the local client computer and the remote sever according to selection”.

Regarding claim 73, Wilkins does not include “storing two different states of the one or more parameters at each of the local client computer and the remote server, one state containing a different set of conflicting parameters”.

Applicant respectfully notes that Office Action did not include explanations to the rejection to claim 28 regarding the limitations of “storing two different states...”.

Regarding claim 75, Wilkins does not include “capturing a history of states of the one or more parameters; and selecting one of the history of states without traversing back through each intermediary state in the history”.

The Office Action cited paragraph [0055] (in rejecting claim 13) which recites:

An alternative embodiment is to use this list to represent a state description of each operation applied to the photo, in which certain operations can be turned on or off. Each operation can still have an optional parameter list associated with the command, but **there is a single "state" for the operation. It is either "on" or "off"**, and if "on", it can have a parameter associated with it. The advantage of this structure is that the operations and the interaction between the operations are clearly defined by the structure, thus providing consistent results regardless of the order that the user has applied the operations. Either the XML syntax could define the order in which the operations are performed, similar to the first embodiment, or the application can define it, independent of the order in which they appear in the XML file. The key point is that each operation is either "on" or "off" and would normally not appear more than once on the edit list. A second sample piece of XML code is included for illustrative purposes:

Paragraph [0055] emphasizes there is only **a single "state" for the operation. It is either "on" or "off"** in the edit list. There is no disclosure about “a history of states of the one or more parameters” or “selecting one of the history of states without traversing back through each intermediary state in the history”.

Regarding claim 76, Wilkins does not include “the one or more parameters include the state of the user interface”.

The Office Action cited paragraph [0055] (in rejecting claim 15) which recites:

An alternative embodiment is to use this list to represent a state description of each operation applied to the photo, in which certain operations can be turned on or off. Each operation can still have an optional parameter list associated with the command, but there is a single "state" for the operation.

The term “state” in Paragraph [0055] refers to state of operation applied to the photo. It is not a state of a user interface.

Regarding claim 80, Office Action cited paragraph [0075] in the rejection of claim 22. Paragraph [0075] recites the following:

“A third embodiment combines the benefits of the first two embodiments. The edit list not only represents the state description of operations, but also includes the ability for one or more of the operations that are part of the state description to be a list of individual operations that are to be applied to the photo, thus merging the two methods”

The phrase “individual operations” in Wilkins simply means “separate or unique operations”. Wilkins does not include a set of parameters that can be used and reused on images associated with a user.

Wilkins therefore does not include “the one or more parameters constitute a personal template, wherein the personal template is configured to describe manipulations to be applied to different images associated with a same user” based on similar arguments made regarding claim 46.

Regarding claim 81, the Office Action cited paragraph [0102] (in rejecting claim 17) which recites the following:

“It should also be noted that the edit list data associated with a reference proxy image can point to multiple digital negatives and other multimedia content used in the creation of the reference proxy image. This can include vector images (such as

PostScript, EPS, or PDF), raster images (such as JPEG, TIFF, or PNG), **text strings**, video, sound, and the like.”

Applicant has carefully examined text strings in the edit list Wilkins. For example, Wilkins describes from paragraph [0035] to paragraph [0074]:

```
[0069] <!--color_adjustment and auto_fix are both enabled and applied to the-->
[0071] <EDIT-COMMAND state="on" type="color_adjustment" red="10" green="-
20" blue="50" />
[0072] <EDIT-COMMAND state="on" type="auto_fix"/>
```

The text strings in the edit list are intended to describe image processing to be applied to the image. Applicant has carefully examined the entire specification of Wilkins, there is no mention of annotation to be inserted in an image and storing the annotation message in an edit list.

Wilkins therefore does not teach “wherein the one or more parameters include annotation to be inserted in the image” based on similar arguments made regarding claim 55.

Regarding claim 82, Wilkins does not teach “wherein the one or more parameters are modified by the computer processor in the local client computer when the local client computer is not in an open session with the remote server, the method further comprising: after the one or more parameters are modified, opening an session between the local client computer and the remote server before the step of synchronizing the one or more parameters on the local client computer and the remote server”.

In sum, one or more elements in each of claims 66-84 are missing in Wilkins. Claims 66-84 cannot be anticipated by Wilkins under Section 102.

CLAIMS 85-90

Claim 85 has similar limitations as claim 66. Based on similar arguments as presented above in relation to claims 66-84, one or more elements in each of claims 85-90 are missing in Wilkins. Claims 85-90 cannot be anticipated by Wilkins under Section 102.

SECTION 103 REJECTIONS

Claims 2 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins as applied to claim 1 above, and further in view of Black et al., U.S. Patent Number 7,222,147 B1.

Claims 24 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins as applied to claim 1 above, and further in view of Tackbary et al., U.S. Patent Number 6,092,054.

In response, claims 2, 24, 29, and 32 have been cancelled. Newly added claims 46-90 do not include limitations recited in previously presented claims 2, 24, 29, and 32.

Withdrawal of Section 103 rejections on claims 2, 24, 29, and 32 is respectfully requested.

CONCLUSION

Applicants believe that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this office action, the Examiner is invited to telephone the undersigned at 650-610-3522.

Respectfully submitted,

Date: December 8, 2008

/Xin Wen/

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